



## THE ISSUES

The applicant argues that Bailey was not available as a 35 USC 103(a) reference at the time the invention was made.

The applicant further argues that, absent Bailey as a reference, the applicant cannot properly argue that the prior art of record taken as a whole did not render the instant invention obvious at the time the invention was made because the examiner's 35 USC 103(a) rejection of claim 1 relies heavily upon Bailey.

The applicant further argues that the incorporation by reference of his Provisional Patent Application; serial no 60/070,405 filed 01/05/98 into the instant patent application constitutes evidence of a constructive reduction to practice of the invention as of the filing date of the Provisional Patent Application.

## ARGUMENTS

The critical dates related to the issue above are:

01/05/98

Provisional Patent Application 60/070,405 was filed for the instant invention.

06/09/98

U.S. Patent No: 5,761,976 to Bailey, was issued.

12/28/98

Patent Application 09/222/282 was filed for the instant invention wherein the first item of the specifications states "This application claims the benefits of Provisional Patent Application 60/070/405 filed 01/05/98.

Authorities relied on are;

MPEP 715.07 (page 700-147, column 1 last sentence of first paragraph.)

"..(filing constitutes a constructive reduction to practice, 37 CFR 1.131).

35 USC 103(a)

"...that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art..."

U.S. Patent No. 5,761,976 to Bailey became available as a 35 USC 103(a) prior art reference as of 06/09/98.

The applicant's Provisional Patent Application filed 01/05/98 constitutes a constructive reduction to practice of the invention and the averments made in the Declaration filed therewith establish that the time that the invention was made, proceeds the date of availability of Bailey as 35 USC 103(a) reference.

Therefore, the examiner's 35 USC 103(a) rejection of the applicant's claim 1 is not properly taken and the applicant request that the examiner so find and that the 35 USC 103(a) rejection of claim 1 be withdrawn and that claim 1 be found to be allowable under 35 USC 103(a)

Differences between the language of claim 1 and that of the Provisional Application arise from the requirement that the applicant disclose the best mode of practicing the invention known to the inventor at the time of filing of the application and the requirement that the claims clearly state and particularly point out that which he regards as his invention.

There being no other issues pending in this patent application the applicant requests that claim 1 be found to be allowable and that his application for a KNIFE INDEXING APPARATUS allowed to issue as a United States Letters Patent.

By



Russell L. Johnson

Patent Agent (26,918)

P.O. Box 161

Weyauwega WI 54983